

PATENT

Application # 10/780,037

Attorney Docket # 1057-002

REMARKS

The Examiner is respectfully thanked for the consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

The Examiner is also thanked for the courtesies extended during the interview on 23 February 2006, during which a provisional election with traverse was made to prosecute Invention II, claims 11-22, 34, 35, and 37-47.

Each of claims 11, 19, 20, 21, 37, and 42 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claim 18 has been cancelled. Claim 49 is new. Claims 11-22, 34, 35, 37-47, and 49 are now pending in this application. Each of claims 11, 20, and 37 are in independent form.

The Anticipation Rejections

Each of claims 11, 13-20, 22, 34, 37-39, 41, and 47 was rejected as anticipated under 35 U.S.C. 102(b). In support of the rejection, various portions of U.S. Patent No. 5,230,127 ("Zukowski") were applied. These rejections are respectfully traversed.

Zukowski fails to establish a *prima facie* case of anticipation. See MPEP 2131. To anticipate expressly, the "invention must have been known to the art in the detail of the claim;

PATENT**Application # 10/780,037****Attorney Docket # 1057-002**

that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim". *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001). The single reference must describe the claimed subject matter "with sufficient clarity and detail to establish that the subject matter existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention". *Crown Operations Int'l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002). Moreover, the prior art reference must be sufficient to enable one with ordinary skill in the art to practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (1965), *cert. denied*, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003) ("A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.") The USPTO "has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (1967).

As explained at MPEP 2111.01, the words of a claim must be given their plain meaning unless they are defined in the specification. Further, in a recent *en banc* ruling, the Federal Circuit held that "[e]ven when guidance is not provided in explicit definitional format, the specification may define claim terms by implication such that the meaning may be found in or ascertained by a reading of the patent documents." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1321, 75 USPQ2d 1321 (Fed. Cir. 2005) (*en banc*), *cert. denied*, 2006 U.S. LEXIS 1154 (U.S. Feb. 21, 2006). "Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification." *Id* at 1313.

Here, the claim terms "wooden", "mortise", "tenon", and "tongue and groove" have been explicitly defined in the specification (see paragraphs 41, 29, 35, and 36 respectively), and those definitions must control examination of those claims that recite these terms.

PATENT**Application # 10/780,037**

Attorney Docket # 1057-002

Specifically, *inter alia*, each of claims 11-22, 34, 35, and 37-47 recite, yet the applied portions of Zukowski do not teach or suggest, expressly or inherently, “wooden portion” or “wooden box-urn”, and “mortise and tenon joints”. For example, because it is true that, as stated by the Office Action, Zukowski’s alleged “first portion is not made of wood”, it must also be true that Zukowski’s alleged “first portion” is not “constructed primarily of wood” as required by the defined term “wooden”, which appears in each of the rejected claims. Thus, Zukowski’s alleged “first portion” **is not and can not be** “wooden” as that term has been defined by Applicant. Further, Zukowski does not teach or suggest, expressly or inherently, “mortise and tenon joints” as that phrase has been defined by Applicant. Accordingly, it is respectfully submitted that the rejection of each of claim s 11-22, 34, 35, and 37-47 is unsupported by the applied portions of Zukowski and should be withdrawn.

Regarding claim 17, the applied portions of Zukowski do not teach or suggest, expressly or inherently, “tongue and groove joints”. Accordingly, it is respectfully submitted that the rejection of claim 17 is unsupported by the applied portions of Zukowski and should be withdrawn.

Moreover, regarding claim 19 (and new claim 49), the applied portions of Zukowski do not teach or suggest, expressly or inherently, the claimed temperature value. Accordingly, it is respectfully submitted that the rejection of claim 19 is unsupported by the applied portions of Zukowski and should be withdrawn.

The Obviousness Rejections

Each of claims 12, 21, 35, 40, and 42-46 was rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of U.S. Patent No. 5,230,127 (“Zukowski”), U.S. Patent No. 5,342,436 (“Thrasher”), U.S. Patent No. 5,765,269 (“Zarth”), and/or U.S. Patent No. 5,381,591 (“Ponger”). These rejections are respectfully traversed.

PATENT

Application # 10/780,037

Attorney Docket # 1057-002

A. Official Notice

To the extent that official notice is explicitly or implicitly utilized to support any rejection, that rejection is respectfully traversed and citation and provision of a reference that supports the rejection is respectfully requested. *See* MPEP 2144.03.

B. Inherency

Inherency "requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002).

To the extent that the present Office Action or any future Office Action intends to rely on inherency to support a claim rejection, Applicant respectfully traverses, respectfully requests provision of proper evidence supporting such rejection, and respectfully requests a detailed explanation of how the "missing descriptive material is necessarily present, not merely probably or possibly present", in any prior art reference cited to support such rejection.

C. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." *See* MPEP 2143.

PATENT**Application # 10/780,037**

Attorney Docket # 1057-002

Moreover, the "Patent Office has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057, reh'g denied, 390 U.S. 1000 (1968). "It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis". *Id.*

"Once the examiner... carries the burden of making out a prima facie case of unpatentability, 'the burden of coming forward with evidence or argument shifts to the applicant.'" *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

D. The Failure to Consider All Claim Limitations

"To establish *prima facie* obviousness..., '[a]ll words in a claim must be considered....'" MPEP 2143.03, quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); see also *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilder*, 429 F.2d 447, 166 USPQ 545, 548 (CCPA 1970); *In re Angstadt*, 537 F.2d 498, 190 USPQ 214, 217 (CCPA 1976); *In re Geerdes*, 491 F.2d 1260, 180 USPQ 789, 791 (CCPA 1974).

As explained above, *inter alia*, each of claim s 11-22, 34, 35, and 37-47 recite, yet the applied portions of Zukowski do not teach or suggest, expressly or inherently, "wooden portion" or "wooden box-urn", and "mortise and tenon joints". The applied portions of the other cited references fail to cure at least these deficiencies of the applied portions of Zukowski.

Also, regarding claim 17, the applied portions of Zukowski do not teach or suggest, expressly or inherently, "tongue and groove joints". The applied portions of the other cited references fail to cure at least this deficiency of the applied portions of Zukowski.

Moreover, regarding claim 19 (and new claim 49), the applied portions of Zukowski do not teach or suggest, expressly or inherently, the claimed temperature value. The applied portions of the other cited references fail to cure at least this deficiency of the applied portions of Zukowski.

PATENT

Application # 10/780,037

Attorney Docket # 1057-002

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, still do not expressly or inherently teach or suggest **every** limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

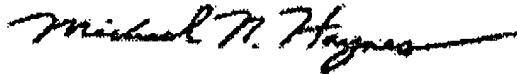
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC



Michael N. Haynes
Registration No. 40,014

Date: 24 April 2006

1341 Huntersfield Close
Keswick, VA 22947
Telephone: 434-972-9988
Facsimile: 815-550-8850